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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,095	06/30/2000	Paul Lapstun	NPA051US	3119

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

HOFFMAN, BRANDON S

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/610,095

Applicant(s)

LAPSTUN ET AL.

Examiner

Brandon Hoffman

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The abstract of the disclosure is objected to because it should not contain "(Figure 48)". Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities:

- When the disclosure switches from one figure to the next, a statement telling the reader that the figures have changed is needed. For example, on page 12, line 21, the reader is never warned that the reference numbers refer to figure 3. Another example is on page 28, line 6, the disclosure went from figure 20 (print head) to talking about the pen, but I am not sure which figure to refer to without flipping through all of them and finding the reference number. Please correct any further occurrences.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 6-12, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al. (U.S. Patent No. 6,081,261) in view of Dymetman et al. (U.S. Patent No. 6,330,976).

Regarding claims 1 and 10, Wolff et al. teaches a method/system for registration of a sensing device for use with a computer system, the method including the steps of:

- Providing a printed registration form including registration information and coded data thereon (col. 2, lines 52-56),
- Receiving in the computer system indicating data from a sensing device, the indicating data including information regarding an identity of the sensing device (col. 2, lines 57-61),
- Deriving, from the indicating data, a correspondence between a registered user of the computer system and the identity of the sensing device (based on the signature stored in the system, the identity of the person writing the signature on the form is identified if the signatures match); and
- Storing, in the computer system, registration data associating an identity of the registered user with the identity of the sensing device (col. 2, lines 52-56).

Wolff et al. does not teach:

- The coded data including an indication of an identity of the form and at least one reference point on the form; and
- The identity of the form and at least one action of the sensing device in relation to the form generated by the sensing device using at least some of the coded data.

Dymetman et al. teaches:

- The coded data including an indication of an identity of the form and at least one reference point on the form (col. 12, lines 34-46); and
- The identity of the form and at least one action of the sensing device in relation to the form generated by the sensing device using at least some of the coded data (col. 12, lines 34-46 and col. 17, lines 16-21).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have the coded data including an indication of an identity of the form and at least one reference point, and the identity of the form and at least one action of the sensing device in relation to the form generated by the sensing device using at least some of the coded data, as taught by Dymetman et al., to the method/system of Wolff et al. It would have been obvious to one of ordinary skill in the art to have the coded data including an indication of an identity of the form and at least one reference point, and the identity of the form and at least one action of the sensing device in relation to the form generated by the sensing device using at least some of the

coded data, as taught by Dymetman et al., to the method/system of Wolff et al. because the coded data including an identity of the form will let the computer system recognize the type of form being used at the current time, i.e., spreadsheet, calendar, word document. Also, the identity of the form and at least once action of the sensing device in relation to the form generated by the sensing device using at least some of the coded data tells the computer system what action to take – one action on the calendar form would perform a different action on the spreadsheet form. This allows the sensing device to be used in many different applications.

Regarding claims 2 and 11, the combination of Wolff et al./Dymetman et al. teaches wherein the at least one action of the sensing device in relation to the registration form includes the formation of handwritten text and/or markings on the form (see col. 17, lines 16-21 of Dymetman et al.).

Regarding claims 3 and 12, the combination of Wolff et al./Dymetman et al. teaches wherein the indicating data regarding the formation of handwritten text and/or markings on the registration form is used to derive the identity of the registered user from information stored in the computer system (see col. 2, lines 57-61 of Wolff et al.).

Regarding claim 6, the combination of Wolff et al./Dymetman et al. teaches:

- Providing a first printed document form including registration information and coded data thereon (see col. 2, lines 52-56 of Wolff et al.),

- The coded data including an indication of an identity of the form and at least one reference point on the form (see col. 12, lines 34-46 of Dymetman et al.);
- Receiving in the computer system indicating data from a registered sensing device, the indicating data including information regarding an identity of said registered sensing device (see col. 2, lines 57-61 of Wolff et al.),
 - The identity of the form and at least one action of said registered sensing device in relation to the form generated by said registered sensing device using at least some of the coded data (see col. 12, lines 34-46 and col. 17, lines 16-21 of Dymetman et al.);
- Identifying a registered user of the computer system from information stored in the computer system using a stored correspondence between the registered user and the received identity of said registered sensing device (based on the signature stored in the system, the identity of the person writing the signature on the form is identified if the signatures match as taught by Wolff et al.); and
- Generating said registration form, wherein the registration information includes an indication of the identity of the registered user (see col. 3, lines 26-31 and 45-46 of Wolff et al.).

Regarding claims 7, 14, and 15, the combination of Wolff et al./Dymetman et al. teaches:

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- Including receiving in the computer system authorizing data from a second sensing device, the authorizing data including information regarding the identity of the second sensing device (see col. 2, lines 57-61 of Wolff et al.),
- The identity of the registration form and at least one action of the second sensing device in relation to the registration form generated by the second sensing device using at least some of the coded data (see col. 12, lines 34-46 and col. 17, lines 16-21 of Dymetman et al.), and
- The second sensing device being associated in the computer system with a second registered user authorized to permit sensing device registrations (banking systems are well known, as well as other systems, to have an authorized person – such as the teller – sign the checks as valid. The check is then accepted because of the authorized signature. Also, in the work environment, a supervisor signs timesheets and other forms from a worker. The forms are accepted because of the supervisor signature).

Regarding claims 8, 16, and 17, the combination of Wolff et al./Dymetman et al. teaches wherein the registration form is printed on demand on the surface of a sheet material including printing said coded data thereon (see col. 11, lines 55-62 of Dymetman et al.).

Regarding claims 9 and 18, the combination of Wolff et al./Dymetman et al. teaches including printing the coded data to be at least substantially invisible in the visible spectrum (see col. 12, lines 65-67 of Dymetman et al.).

Claims 4, 5, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al. (U.S. Patent No. 6,081,261) as modified by Dymetman et al. (U.S. Patent No. 6,330,976), and further in view of Skarbo et al. (U.S. Patent No. 6,317,777).

Regarding claims 4 and 13, the combination of Wolff et al./Dymetman et al. teaches the list form having coded data including an indication of an identity of the list form and at least one reference point on the list form (see col. 12, lines 34-46 of Dymetman et al.).

However, the combination of Wolff et al./Dymetman et al. does not teach including the step of using the indicating data regarding the formation of handwritten text and/or markings on the registration form to generate, from information stored in the computer system, a list form indicating registered users corresponding to the indicating data.

Skarbo et al. teaches including the step of using the indicating data regarding the formation of handwritten text and/or markings on the registration form to generate, from information stored in the computer system, a list form indicating registered users corresponding to the indicating data (col. 7, lines 36-40).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the step of generating a list form of registered users corresponding to the indicating data, as taught by Skarbo et al., to the method/system of Wolff et al./Dymetman et al. It would have been obvious to one of ordinary skill in the art to combine the step of generating a list form of registered users corresponding to the indicating data, as taught by Skarbo et al., to the method/system of Wolff et al./Dymetman et al. because the list form shows all available registered users to make it easier to point and select a user instead of having to remember all registered users.

Regarding claim 5, the combination of Wolff et al./Dymetman et al. in view of Skarbo et al. teaches including the step of receiving in the computer system further indicating data from the sensing device, the further indicating data including information regarding the identity of the list form and at least one action of the sensing device in relation to the list form generated by the sensing device using at least some of the coded data, the further indicating data being used to determine one of the listed registered users for correspondence with the sensing device (see col. 17, lines 16-21 of Dymetman et al.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Hoffman whose telephone number is 703-305-4662. The examiner can normally be reached on M-F 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Branda Hefner

BH
12/23/03

Emmanuel L. Moise
EMMANUEL L. MOISE
PRIMARY EXAMINER